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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,573	02/09/2004	Gary R. Lomp	I-2-0104.6US	1466

24374 7590 04/05/2006

VOLPE AND KOENIG, P.C.  
DEPT. ICC  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103

EXAMINER

SANTIAGO, ENRIQUE L

ART UNIT PAPER NUMBER

2628

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/775,573

Applicant(s)

LOMP ET AL.

Examiner

Enrique L. Santiago

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                            |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-19-05</u> | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION****Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,584,091 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is that the present claims do not include “CDMA” and “at least one... delay unit” associated with an antenna, however the present claims include “a plurality of delay units” associated with “a plurality of antennas” it is obvious that a group consisting of a plurality of elements contains at least one element. Also the omission of an element and its function where not needed is obvious. *Ex parte Rainu*, 168 USPQ 375 (PTO Bd. Of App. 1969). The omission

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of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Current claims 10/775,573      similar limitations as      Claims of US Patent no. 6,584,091

1	1
3+4	2
5	3
6	4
7+10	5
8	6
9	7
11	8
12	9

Claims 13, 14, 16 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 10, 11 and 15 of U.S. Patent No. 6,584,091 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is that the present claims do not include "CDMA...adding a copy...fixed...received". The omission of an element and its function where not needed is obvious. *Ex parte Rainu*, 168 USPQ 375 (PTO Bd. Of App. 1969). The omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Current claims 10/775,573      similar limitations as      Claims of US Patent no. 6,584,091

13	10
14	11
13+16	15
17	3

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Claims 2 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10 of U.S. Patent No. 6,584,091 B2 in view of US Patent no. 5,819,181.

U.S. Patent No. 6,584,091 B2 does not claim a communication station wherein the time delay is adjustable; however in similar art U.S. Patent No. 5,819,181 teaches said feature (see column 2, lines 64-66). Therefore it would have been obvious to one skilled in the art at the time of the invention to combine said feature with those claimed by US 6,584,092, because it would be used to execute (in the case of a mobile station moving from one coverage area to a different area), a handoff of the mobile station from the first coverage area to the second (see column 3, lines 1-4).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Enrique L Santiago whose telephone number is (571) 272-7648. The examiner can normally be reached on Monday to Thursday from 6:30 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman whose telephone number is (571) 272-7653, can be reached on Monday to Friday from 7:00 A.M. to 3:30 P.M.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Faxed to: 571-273-8300

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Hand carried deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Enrique L. Santiago

March 29, 2006



MARK ZIMMERMANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER